

REMARKS

Claims 1 and 5-8 are pending. No new matter has been added by way of the present amendment. For instance, an inadvertent typographical error has been corrected in the specification. Moreover, the recitation of tin (having the chemical symbol Sn) has been added to claims 1 and 5. Support for this amendment can be found in the present specification at page 7, paragraph 36. Accordingly, no new matter has been added.

Applicants further submit that no new issues have been raised by way of the present amendment. The previously omission of "tin" from the Markush language in claims 1 and 5 was inadvertent and does not place the burden of additional search and/or consideration on the part of the Examiner. The present claims are narrower in scope than the claims already examined which related to a "ternary phase layer" generically and not a layer as currently described in claims 1 and 5. Accordingly, no new issues have been raised.

In the event that the present submission does not place the application into condition for allowance, entry thereof is respectfully requested as placing the application into better form for appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

***Issues Under 35 U.S.C. § 112, First Paragraph***

The Examiner has rejected claims 1 and 58 under 35 U.S.C. § 112, first paragraph, for the reasons recited at page 2 of the outstanding Office Action. Applicants respectfully traverse this rejection.

The Examiner has rejected the recitations of "group consisting of" in claims 1 and 5. The Examiner asserts that this language constitutes new matter and should be replaced with "including" or "comprising". Applicants respectfully disagree with the Examiner. The language relating to "group consisting of" is well understood as Markush language which is perfectly acceptable under U.S. practice. The Examiner's attention is drawn to paragraph 36 at page 7 of the specification which explains that the Ti film can use not only Ti but alternatively one of Tin, Ta, W, V, Cr, Mn, Zr, Mo and Hf. Thus, another way of expressing these elements in the alternative is to use the Markush language currently claimed. Thus, this subject matter does not constitute new matter.

Further, replacing the phrase "group consisting of" with "including" or "comprising" would be improper under the present circumstances. In particular, the claims only currently require one of the metals recited in the Markush group. However, changing the language "group consisting of" to "including" or "comprising" may actually infer that each of the metals must be present. This is incorrect and does not conform with the present description. Accordingly, Applicants respectfully submit that the Examiner's rejection is improper and should be withdrawn.

In view of the above, Applicants respectfully submit the present application is in condition for allowance. The Examiner is respectfully requested to withdrawal all rejections and allow the currently pending claims.


If the Examiner has any questions or comments, please contact Craig A. McRobbie, Reg. No. 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

Appl. No. 10/620,608

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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